

## **REMARKS**

### **A. INTRODUCTION**

Claims **1-16, 18-31 and 33-98** are pending.

Claims 1-7, 11-15, 18-27, 30, 31, 33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85 and 87-98 are rejected.

Claim 8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 and 86 were withdrawn previously as being directed to non-elected subject matter.

Claims 1, 13, 25, 49, 61 and 73 are considered by the USPTO to be generic [See Office Action mailed October 22, 2004 (Paper No./Mail Date 10152004)].

Claims 17, 32 and 99-110 were previously cancelled.

Upon entry of this Amendment:

- Claims 1-16, 18-31, 33-98 and 111-113 will be pending
- Claims 1, 49, 94 and 97 will be amended
- Claims 111-113 will be added

### **B. STATUS OF THE CLAIMS: 8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 AND 86 ARE ALSO PENDING**

Applicants again note that claims 8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 and 86 are withdrawn, and have not been cancelled. Accordingly, the present amendment includes the text of these withdrawn claims. The Office Action again incorrectly lists only Claims 1-7, 11-15, 18-27, 30, 31, 33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98 as claims pending.

Applicants respectfully request that the status of the claims be corrected in the record or a reason provided why the USPTO believes Claims 8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 and 86 are not pending.

### **C. SECTION 101 REJECTION**

Claims 1-7, 11-15, 18-27, 30-31, 33, 35-37, 39-45, 49-55, 59-63, 65-75, 78-81, 83-85, 87-94 and 97-98 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicants respectfully traverse the Examiner's Section 101 rejection.

However, solely for business reasons and in order to expedite allowance of this Application, Applicants have amended independent Claims 1, 49, 94 and 97 in order to recite particular desirable embodiments providing for specified functions

to be performed by a controller comprising at least one processor. No new matter is provided by this Amendment.

For at least these reasons, Applicants respectfully request the withdrawal of the Section 101 rejections of Claims 1-7, 11-15, 18-27, 30-31, 33, 35-37, 39-45, 49-55, 59-63, 65-75, 78-81, 83-85, 87-94 and 97-98.

**D. SECTION 103(A) REJECTIONS**

Claims 1-7, 11-15, 18-27, 30-31, 33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85 and 87-98 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gamble (U.S. Patent No. 6,014,632), and further in view of Lencki (U.S. Patent No. 2002/0049617).

Applicants respectfully traverse the Examiner's Section 103(a) rejections for at least the reasons stated in their prior reply, filed October 13, 2008, which is incorporated herein in its entirety.

In response to some of the particular points raised in the Office Action's Response to Arguments section, Applicants respectfully note that they did not simply assert patentability. To the contrary, Applicants submitted first that Lencki is not prior art for the subject matter explicitly relied upon in the Office Action as evidence supporting the grounds of rejection. The Office Action ignores this argument. Accordingly, no unrebuttable prima facie case of obviousness has been presented.

Further, contrary to what is asserted in the present Office Action, Applicants explicitly stated that Lencki does not teach or suggest specific features of the pending claims.

Lencki '617 fails to cure the deficiencies of Gamble. The Office Action relies on Page 13, ¶ 0182 of Lencki '617 as disclosing "offering a benefit to the customer towards the transaction if the customer adopts the preventative treatment" and "receiving an indication that the customer agrees to adopt the preventative treatment."

This passage of Lencki '617, however, contains no such teaching. Page 13, ¶ 0182 of Lencki '617 (continued on page 14) lists a number of example rules and/or recommendations for a member to use in selecting insurance benefits, some of which relate to preventative treatments. However, none of these rules or recommendations offer a benefit toward a third party transaction in which a customer is involved if a customer adopts a preventative treatment.

For example, no combination of any subject matter described in Gamble and Lencki '617 would provide for *offering a benefit to a customer towards a*

*transaction (with a third party) if that customer adopts a preventative treatment that has been determined for that customer.*

Therefore, even if Gamble and Lencki '617 were combined as suggested, and we respectfully submit there is no teaching or suggestion for such a combination, the present invention would not be the result. Any such combination would fail to include offering a benefit to the customer toward the transaction if the customer adopts the preventative treatment that has been determined for the customer, and would fail to include receiving an indication that the customer agrees to the preventative treatment, and would fail to include providing the benefit (towards the transaction), as required by independent claims **1 and 46-48**. Lencki '617 at most describes offering additional services (for additional consideration) separate from existing transactions, with no benefit whatsoever offered toward the existing transaction.

Furthermore, even if the customer purchases these additional services, there is no agreement by the customer to actually adopt these services, just as there is no mechanism for verifying that the customer has adopted the services once the services have been purchased. Applicant's remind the Examiner that this and all of other limitations must be given the broadest reasonable interpretation in a manner consistent with Applicants' specification. MPEP 2111. In addition, even if the Examiner determines that the limitation is entitled to a different interpretation than the interpretation being advanced by Applicants, the Examiner's updated search should nevertheless "cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment," and "the best reference should always be the one used." MPEP 904.03. Therefore, the updated search and cited prior art must include the interpretation advanced by Applicants. Moreover, the Examiner should not "make a new search in the mere hope of finding something." MPEP 704.01. This is especially true when, as here, there have been numerous Office Actions on the merits and a thorough search has already been performed and updated several times.

In addition, since claims **2-7, 11-15, 17-27, 30-33, 35-37 and 39-45** each directly or indirectly depend on claim **1**, these dependent claims should be allowable for at least the same reasons.

In view of the above remarks, the Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejections of claims **1-7, 11-15, 17-27, 30-33, 35-37 and 39-48**.

#### **E. ADDITIONAL COMMENTS**

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited

reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

**F. NEWLY-ADDED CLAIMS 111-113 ARE PATENTABLE OVER THE CITED REFERENCES**

Newly-added Claims 111-113 are patentable over the cited references. No new mater has been added.

**G. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES**

We understand that a two-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$490.00

Deposit Account: 50-0271

Order No.: 00-047

Please credit any overpayment to the same account.

## **H. CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 438-6408 or via electronic mail at [mardowns@finchamdowns.com](mailto:mardowns@finchamdowns.com).

Respectfully submitted,

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